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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KIM, CHONG HWA

ART UNIT PAPER NUMBER

3682

DATE MAILED: 05/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8K

Office Action Summary

Application No.

09/658,389

Applicant(s)

THOMSON ET AL.

Examiner

Chong H. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 7,11,14,16,23,32 and 39-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12,13,15,17-22,24-31 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

The Examiner acknowledges the applicant's Reconsideration filed Mar 17, 2003 in response to the Office action made on Dec 11, 2002.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8, 9, 19, 28, and 33-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 8, 19, 28, and 33 recite the limitation wherein the fastener receiving passageway in each clamp member is canted at a predetermined angle from a line parallel to an axis of the imaginary cylinder. Also, the specification, as originally filed, describes the way in which the clamps are drawn together by the fastener so that the clamps might (in a way) rotate relative to one another so that the clamps, with the proximal contacting surfaces to each other, engage (or touch) the steering tube. However, the specification does not provide adequately or describe in such a clear and concise way as to how the clamp is moved (or rotated transversely to the axis 49) in a confined and tight clamp receiving passageway 36 as shown in Figs. 2 and 13. It appears that the clamp receiving passageway 36 must be provided with a space wherein the clamp 40 can rotate transversely or reshape the clamp receiving

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passageway 36 so that the passageway can accommodate the "canting" of the clamp 40 in order for such "urging" of the clamps to work properly. In such a tight and confined passageway 36, the fastener 46 may be inserted into the first fastener receiving passageway 42b, but it would be almost impossible to engage the second fastener receiving passageway 42c without breaking the passageway 36 or the clamp members 40 (see Fig. 14A).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3, 10, 12, 13, 15, 17, and 20-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/658,509 in view of Cheng, U.S. Patent 5,477,747.

The copending Application No. 09/658,509 recites the limitations of the bicycle stem comprising the body portion, the handlebar clamping portion, the handlebar clamping member, the steering tube clamping portion, and the steering tube clamp, wherein the body portion, the handlebar clamping portion, and the steering tube clamping portion are integrally formed as a monolithic unit, the fasteners for securing the handlebar clamping member having a recess and

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generally a rectangular shape to the handlebar clamping portion having a recess and generally a rectangular shape, the body portion being a tubular shape with a hollow interior, and a steering tube clamp in the clamp receiving passageway and comprising a pair of cooperating clamp members aligned in side-by-side relation and comprising respective portions defining an imaginary cylinder and a recess therein for the steering tube extending for greater than a predetermined angle, but fails to recite each clamp member having at least one fastener receiving passageway for receiving at least one fastener for urging the clamp members together to engage the steering tube, the pair of clamp member each having a same shape and an end having a circular shape.

Cheng shows, in Figs. 1-3, a bicycle stem comprising a steering tube clamping portion 22 having a tubular shape defining a steering tube receiving passageway 23 therethrough, and wherein the steering tube clamping portion has a clamp receiving passageway 24 therein transverse to the steering tube receiving passageway and in communication therewith; and further comprising a steering tube clamp 28 in the clamp receiving passageway and comprising a pair of cooperating clamp members 28 each having a same shape and an end having a circular shape, aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess 29 therein for the steering tube, each clamp member having at least one fastener receiving passageway 30 therein offset a predetermined distance from an axis defined by the imaginary cylinder (in Fig. 2, the sectional view of the clamp members 28 shows that the hole 30 is offset from the center axis of the clamp members), and at least one fastener 36 extending between corresponding fastener receiving passageways of the pair of clamp members

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for urging the clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the clamping device of the copending Application No. 09/658,509 with the pair clamp device of Cheng in order to provide a tighter and more versatile clamping device so that the operation of the bicycle is not compromised.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 10, 12, 13, 17, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng.

Cheng shows, in Figs. 1-3, a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising;

a body portion 20 having opposing first and second ends (21, 22);

a handlebar clamping portion 21 connected to the first end of the body portion;

a steering tube clamping portion 22 connected to the second end of the body portion and having a tubular shape defining a steering tube receiving passageway 23 therethrough, the

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steering tube clamping portion also having a clamp receiving passageway 24 therein transverse to the steering tube receiving passageway and in communication therewith;

a steering tube clamp 28 in the clamp receiving passageway and comprising a pair of cooperating clamp members 28 aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess 29 therein for the steering tube, each clamp member also having at least one fastener receiving passageway 30 therein offset a predetermined distance from an axis defined by the imaginary cylinder (in Fig. 2, the sectional view of the clamp members 28 shows that the hole 30 is offset from the center axis of the clamp members), and at least one fastener 36 extending between corresponding fastener receiving passageways of the pair of clamp members for urging the clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube;

wherein the fastener receiving passageway are offset the predetermined distance from the axis of the imaginary cylinder in a direction away from the recess;

wherein the body portion, handlebar clamping portion and steering tube clamping portion are integrally formed as a monolithic unit;

wherein the recess for the steering tube extends for greater than a predetermined angle;

wherein the pair of clamp members have a same shape; and

wherein each clamp member comprises an end having a circular shape.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-6, 18, 24-27, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng in view of Roddy, U.S. Patent 5,881,606.

Cheng shows, as discussed above in the rejection of claim 1, the bicycle stem comprising the steering tube clamping portion having a steering tube clamp with at least one fastener wherein the fastener is a bolt having an enlarged head and a threaded shaft extending outwardly therefrom, but fails to show a first fastener and a second fastener and extending in opposite directions from each other.

Roddy shows, in Figs. 2 and 4, a bicycle stem 10 comprising a body portion having a steering tube clamping portion 14, wherein the clamping portion 14 comprises a steering tube clamp 17, 18 aligned as a pair of cooperating clamp members in side-by-side relation and wherein a first bolt 21 and a second bolt 21 extend in opposite direction for urging the clamp members together to engage the steering tube 12.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the single fastener of Cheng with the plurality of fasteners extending in opposite direction as taught by Roddy in order to provide a tighter and more securing clamping device so that the operating the vehicle is safer.

9. Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng in view of Lai, U.S. Patent 5,509,328.

Cheng shows, as discussed above in the rejections of claims 1 and 17, the bicycle stem comprising the handlebar clamping portion 21 connected to the body portion, but fails to show two separate clamping portions to clamp the handlebar.

Lai shows, in Fig. 2, a bicycle stem comprising a handlebar clamping portion 31 connected to a first end of a body portion 21, wherein a handlebar clamping member 32 cooperating with the handlebar clamping portion 31 to clamp the bicycle handlebar therebetween.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the single clamping portion of Cheng with the separate clamping portions as taught by Lai in order to provide a more convenient way to secure the handlebar so that the labor is reduced.

Response to Arguments

10. In response to the applicant's argument regarding the rejection made under 35 U.S.C. 112, first paragraph, wherein "the Examiner has failed to meet the burden of establishing a reasonable basis to question the enablement provided for the claimed invention", it is the Examiner's view that the Examiner has met the burden of establishing a reasonable basis to question the enablement. The reasonable basis, as discussed above in the paragraph 2, is the fact that the clamp receiving passageway 36 must be provided with a space between the inner surface of the passageway 36 and the outer surface of the clamp 40 wherein the clamp 40 can rotate transversely or "cant"; or the clamp receiving passageway 36 must be reshaped so that the passageway can accommodate the "canting" of the clamp 40 in order for such "urging" of the

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clamps to work properly. However, neither the drawings nor the specification as originally filed shows or teaches or suggests such configurations.

Furthermore, in response to the applicant's argument that the Examiner's assertion that it would be almost impossible to engage the second fastener receiving passageway 42c without breaking the passageway 36 or the clamp members 40 is made without any acceptable evidence or reasoning, it is the Examiner's contention that reasoning was provided in the previous Office action. One of the reasoning was that the applicant's specification or drawings had failed to discuss or show such occurrence would not happen. Furthermore, the Examiner had stated that "(if) none of the elements is damaged by the engagement of the fastener, then the clamp members would fail to engage the steering tube, thus failing to perform as a bicycle stem as the invention has contented." In other words, the clamp members going from Fig. 14A to Fig. 14B would be impossible because the space required within the passageway 36 as shown in Fig. 14B needs to be greater than the space provided in Fig. 14A.

11. In response to the applicant's argument regarding the Double Patenting rejection, it is the Examiner's position that the Double Patenting rejection is proper. First of all, the co-pending patent application 09/658,509 is directed to at least similar aspects of the bicycle stem. One being adapted to be attached to the steering tube and the other being adapted to attach the handlebar does not mean that those stems are completely different. The steering tube and the handlebar are the environment in which the claimed bicycle stem is utilized in. Nevertheless, the bicycle stems disclosed in the present invention is same as the bicycle stem disclosed in the co-pending patent application 09/658,509.

It is reminded that the rejection was not based on the disclosure in the specification, but on the limitations recited in the claims of the co-pending patent application 09/658,509. As discussed above in paragraph 5, the claims 1-27 of the co-pending patent application 09/658,509 recite every element in claims 1-3, 10, 12, 13, 15, 17, and 20-22 of present invention except each clamp member having at least one fastener receiving passageway for receiving at least one fastener for urging the clamp members together to engage the steering tube, the pair of clamp member each having a same shape and an end having a circular shape.

Furthermore, in reference to the imaginary cylinder recited in claims 1 and 17, Cheng does disclose or teach such feature as discussed further in the following paragraph. (Also, see paragraphs 4 and 6 above for detailed discussion.)

12. In response to the applicant's argument that Cheng fails to show the clamp members having outer portions defining an imaginary cylinder with an axis and a fastener receiving passageway being offset from the axis, it is the Examiner's position that Cheng shows, in Fig. 2, the fastener receiving passageway 30 being offset a predetermined distance from the axis defined by the imaginary cylinder that is defined by the outer surface portions of the clamp members 28. As shown in Fig. 2, the sectional view of the clamp members 28 has the fastener receiving passageway 30 wherein the passageway 30 is offset from the axis of the imaginary cylinder of the clamp members. The imaginary cylinder is defined by the outer surface portions of the clamp members. The clamp members 28, as shown in Fig. 2, show that the distance from the inner surface of the passageway 30 to the outer surface portion of the member 28 that is positioned on the right side of the passageway 30 is shorter than the distance from the inner surface of the passageway 30 to the outer surface portion of the member 28 that is positioned on

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the left side of the passageway 30. Therefore, there exists an offset distance of the passageway 30 from the axis of the imaginary cylinder that is defined by the outer surface portions of the clamp member 28. Now, the argument by the applicant appears to concentrate on the notion that the definition of the word "cylinder" is nothing but a circular (perfect circle) cylinder. However, the word "cylinder" is defined by Merriam Webster's Collegiate Dictionary, 10th Edition, as "the surface traced by a straight line moving parallel to a fixed straight line and intersecting a fixed planar closed curve." There is nothing in the definition that a "cylinder" must be of the circular shape. Therefore, the imaginary cylinder interpreted by the Examiner should not be understood as a circular cylinder from the reduced diameter portions or enlarged diameter portions of the clamp members 28. Rather, it should be construed as the imaginary cylinder that is an oval shaped cylinder having a surface that coincide with both reduced and enlarged diameter portions of the clamp members 28. As a result, the axis for the imaginary cylinder should be offset from the fastener receiving passageway 30.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922. The examiner can normally be reached on Monday - Friday; 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on (703) 308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

chk
April 30, 2003


CHONG H. KIM
PRIMARY EXAMINER